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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,513	12/11/2001	Sachio Murai	IID-0200	4813

23353 7590 06.11.2003

RADER FISHMAN & GRAUER PLLC
LION BUILDING
1233 20TH STREET N.W., SUITE 501
WASHINGTON, DC 20036

EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 06/11/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/009,513

Applicant(s)

MURAI ET AL.

Examiner

Marc S. Zimmer

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 5-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 7. 6) ☐ Other: _____

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3 and 4 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a specified weight ratio of hard to soft segments, does not reasonably provide enablement for a specified molar ratio of hard to soft segments. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to prepare the invention commensurate in scope with these claims. Basically, there is question as to whether the ratio to be satisfied is actually a molar ratio or, instead, a weight ratio in accordance with the disclosure at page 15, lines 15-18.

Claim Analysis

It is noted that the phrase, "for forming a primer layer between an organic glass base material and a silicone based hardening coating film" is merely a recitation of intended use. Section 2112.02 provides direction as to how phrases such as this are to be treated: "If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d

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473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) ("where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation"); *Kropa v. Robie*, 187 F.2d at 152, 88 USPQ2d at 480-81 (preamble is not a limitation where claim is directed to a product and the preamble merely recites a property inherent in an old product defined by the remainder of the claim). In view of these rulings, the aforementioned phrase is ignored for the purpose of evaluating the claim(s) against the prior. Accordingly, Applicant is essentially claiming a thermoplastic polyester elastomer of undefined constitution. Likewise, the fact that the metal oxide particulate of claim 2 is added as an optical interference control agent is immaterial as this is, again, only a statement of intended use. Therefore, claim 2 simply contemplates a composition comprising a thermoplastic polyester elastomer and a metal oxide filler. Although there are literally dozens of documents that disclose all of the limitations of at least claims 1 and 4, only the most comprehensive teachings will be described herein for brevity.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Higuchi et al., U.S. Patent # 5,704,854. Higuchi discloses a golf ball having multilayered construction wherein the intermediate layer (column 2, lines 59-67 through column 3, lines 1-34) is comprised of a thermoplastic polyester elastomer derived from terephthalic acid and a mixture of butanediol and polyoxyalkylene glycol. It is contemplated in column 3, lines 21-26 that inorganic fillers such as zinc oxide or titanium oxide may be incorporated into the elastomer matrix.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by the abstract of Kuratsuji et al., J 59-45349 A. They disclose a polyether ester block copolymer elastomer containing a hard segment and soft segment to which is added a nucleating agent and titanium dioxide.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuratsuji et al., JP 59-45349 A and the corresponding abstract. The abstract further discloses that the ratio of hard to soft segments is in the range of 15:85 to 50:50, which substantially overlaps the range provided by the Applicant. Also, the starting materials

from which the copolymer is made are similar to those employed by Applicant (polyether glycol for the soft segment and low molecular weight alkylene diols for forming the hard segment according to the bracketed portion in the upper right column on page 326.) Insofar as the starting materials used to prepare the thermoplastic elastomer and their quantities are similar, the hardness and bend elasticity limitations are inherently satisfied.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Gyobu et al., U.S. patent # 6,242,560. Gyobu discloses a polyester thermoplastic elastomer that adheres to specific melting- and softening point limitations and comprises at least the three types of units exhibited at the top of column 3 and, optionally, those represented by formula (IV).

Election/Restrictions

Applicant's election with traverse of group I in Paper No. 6 is acknowledged. The traversal is on the ground(s) that a search of all of the claims would not be unduly burdensome to the Examiner as they are all sufficiently related. The Examiner disagrees. As was explained *supra*, the intended application of the primer composition of group I is immaterial. Therefore, the Examiner was able to focus his search of group I on the materials, their properties, and any additives added thereto. This search would not necessarily have been expected to unearth references germane to the inventions of groups II and III insofar as they did not contemplate the primer of group I.

As for groups I and IV, had the Applicant claimed a method of adhering a silicone hardcoat to an optical element, and the article prepared by the method, these claims

would have been inseparable according to PCT practice because the Examiner could not have easily demonstrated that the inventions lacked a common special technical feature. Applicant has, instead, claimed a clearly unpatentable product/composition and a laminate using the same. Because polyester elastomers are indisputably well known, there was no special technical feature linking groups I and IV. Therefore, restriction was proper.

The requirement is still deemed proper and is therefore made FINAL.

Claims 5-26 are drawn to an invention nonelected with traverse in Paper No. 6. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 703-605-1176. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Robert Dawson,
Supervisor, Patent Examiner
For Art Unit 1700